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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,084	04/06/2001	Isabelle Bara	05725.0853	2725
7590	02/13/2004			
Finnegan Henderson Farabow Garrett & Dunner 1300 I Street NW Washington, DC 20005			EXAMINER METZMAIER, DANIEL S	
			ART UNIT 1712	PAPER NUMBER

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,084

Applicant(s)

BARA, ISABELLE

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 26-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 26-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1 and 26-88 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 12, 2003 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 26-37, 39-47, 49, 53-59, 62-64, 67-68, 73-74, 77-80 and 82-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Harvey et al, US 4,357,313. Harvey et al (abstract; column 2, lines 14-26; column 4, lines 38-47; and examples) discloses toothpaste having a solid phase employing 0.5 to 10% by weight of a gelling agent and a liquid phase. Harvey et al (examples) sets forth an aqueous sorbitol solution with a gelling agent and characterizes the gelling agent phase as a solid. The Harvey et al compositions employ polyethylene glycol having a molecular weight of about 1000 or 1500 g/mol. This equates to about 23 or 34 oxyethylene units

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respectively. The Harvey et al compositions employ 1 wt % of a flavoring component, disclosed at column 4, lines 38-47 as oils of various flavors. The Harvey et al compositions read on the claims solid aqueous gels wherein the flavoring oils read on the fatty phase.

The Harvey et al reference discloses solid aqueous gels as claimed by the use of the disclosed gelling agents. The claims do not distinguish based on the term solid, which is undefined in the claim or gel, also undefined in the claims.

Several of the dependent claims further define species of the genus but fail to further limit the genus to said species. In said relationship, the claims read on the remaining species of the genus. An example is claim 27 wherein the synthetic gels of polyesters are further defined but the claim does not define the gelling agent as the synthetic gels of polyesters.

4. Claims 1, 26-37, 39-40, 67-68, 71, 73-75 and 78-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Ciba Specialty Chemicals holdings, Inc., EP 875 244 A2 (hereafter Ciba). See examples, particularly examples 11-17, page 6, lines 50-55. Ciba discloses the combination of an oil phase (A) and a water phase (B) to form a solid gel in examples 11-17. The examples employ β -glucan and PEG 60. PEG 600 equates to PEG having about 13 or 14 oxyethylene groups. Furthermore, examples 16 and 17 employ xanthan gum and a solvent other than water.

Several of the dependent claims further define species of the genus but fail to further limit the genus to said species. In said relationship, the claims read on the remaining species of the genus. An example is claim 27 wherein the synthetic gels of

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polyesters are further defined but the claim does not define the gelling agent as the synthetic gels of polyesters.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 38, 41-66, 69-70, 72, 76-77 and 84-88 are rejected under 35 U.S.C.

103(a) as being unpatentable over Ciba Specialty Chemicals holdings, Inc., EP 875 244 A2 (hereafter Ciba), optionally in view of Roulier et al, WO 97/17055, as evidenced by patent family member US 6,045,814. See examples, particularly examples 11-17, page 6, lines 50-55. Ciba discloses the combination of an oil phase (A) and a water phase (B) to form a solid gel in examples 11-17 as set forth in the above anticipation rejection.

Ciba differ from the instant claims in the exemplified disclosure of formulations tailored utility, eg., hair care, skin care, and the particular additives therefore, eg., pigments, PEG-12, etc..

Ciba (page 2, lines 33 et seq) discloses the compositions may be tailored to hair care, skin care products, the use of Vaseline, jojoba oils, other components including (page 3, lines 19 et seq) solvents such as ethanol and glycerol; antioxidants, further viscosity improving agents (lines 35-36); further uv absorbers including TiO₂, ZnO and mica.

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It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ PEG-12 as an obvious solvent material broadly taught in the Ciba reference (page 3, lines 30) as an obvious equivalent to the PEG-14 exemplified. Said materials differ in one or two oxyethylene groups. Due to their analogous structures, one having ordinary skill in the art at the time of applicant's invention would have expected said materials to function substantially the same as those exemplified. Said PEG-12 reads on the broad disclosure of PEG in Ciba and applicants have not disclosed nor shown criticality for the particular PEG-12 over PEG 14 exemplified in Ciba.

It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the various additives of the dependent claims, which are broadly taught and contemplated in the Ciba reference for the formulations tailored to a specific utility, eg., hair care, skin care, and employing the particular additives therefore, eg., pigments.

To the extent Ciba does not disclose each of the additives, Roulier et al discloses conventional additives to solid cosmetic compositions including the use of numerous overlapping hydrophilic gelling agents. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the various additives of the dependent claims taught in the Roulier et al reference in the Ciba compositions for their art recognized functions taught in the Roulier et al reference.

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The methods claims flow directly from the conventional use of the compositions disclosed in the Ciba optionally in view of the Roulier et al references for their disclosed functions.

Response to Arguments

7. Applicant's arguments with respect to claims 1 and 26-88 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's comment regarding the date of the October 9, 2003 interview are correct. The numbers for the day and month were transposed. The examiner regrets any inconvenience. Regarding applicants assertion that the serial number is incorrect in one of the interview summaries, the interview summaries of record appear to have the correct serial number.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
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DSM